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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,849	11/07/2000	Alan S. Fisher	2043.086US2	8858

49845 7590 11/28/2006

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EXAMINER

AKINTOLA, OLABODE

ART UNIT PAPER NUMBER

3691

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/706,849	FISHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Olabode Akintola	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3691

Claims 18-24, 26-33, 35-42, 44-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 50-99 of U.S. Patent No. 6243691. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 18 (representing the independent claims 18, 26, 35, 44) of Application Serial No. 09/706849 substantially recites the limitations of claim 50 of U.S. Patent No. 6243691. The claim merely omits the underlined limitations of claim 50 of U.S. Patent No. 6243691 and replaces them with the bolded limitations as shown in comparison table 1 below.

U.S Patent No. 6243691	Application Serial No. 09/706849
Claim 50	Claim 18
<p>50. A computer system for conducting an auction <u>business over</u> a computer network, the system comprising:</p> <p>a posting means for posting to a computerized merchandise catalog information that is accessible across the computer network, the information describing each lot in a plurality of lots <u>that is</u> available for auction, each lot including at least one item, the posting means available to add a lot for auction during an auction of another lot, wherein the information related to items in each lot is <u>substantially continuously</u> updated in the merchandise catalog as items in each lot are made available for auction;</p> <p><u>an auction selection means for associating each lot of the plurality of lots with an auction format selected from a plurality of auction formats;</u></p> <p>a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots;</p> <p>a bid validation means for examining the bid; and</p> <p>a bid categorizing means for determining whether the bid is successful or unsuccessful.</p>	<p>18. A computer system for conducting an auction through a computer network, the system comprising:</p> <p>a posting means for posting to a computerized merchandise catalog information that is accessible across the computer network, the information describing each lot in a plurality of lots available for auction, each lot including at least one item, the posting means available to add a lot for auction during an auction of another lot, wherein the information related to items in each lot is <b>automatically</b> updated in the merchandise catalog as items in each lot are made available for auction;</p> <p>a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots;</p> <p>a bid validation means for examining the bid; and</p> <p>a bid categorizing means for determining whether the bid is successful or unsuccessful.</p>

comparison Table 1

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cited steps as indicated in claim 50 of U.S. Patent No. 6243691 since the omission and/or addition of the cited limitations would have not changed the system/method by updating the merchandise catalog as items are made available for auction. Specifically, the ordinary skilled artisan would have been motivated to modify claim 50 of U.S. Patent No. 6243691 by replacing the underlined portions with the bolded limitations in claim 18 of Application Serial No. 09/706849. The cited substitute elements in claim 18 of Application Serial No. 09/706849 would have not in any way interfered with the functionality of the steps previously claimed in U.S. Patent No. 6243691, which would have continued to perform the same function of updating the merchandise catalog as items are made available for auction.

Furthermore, dependent claims 19-24, 27-33, 36-42 and 45-51 of Application Serial No. 09/706849 recite all the limitations of claims 50-99 of U.S. Patent No. 6243691. Therefore, the conflicting claims are rejected for not being patentably distinct from claims 50-99 of U.S. Patent No. 6243691.

With regards to dependent claims 25, 34, 43, 52, these claims are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 50-99 of U.S. Patent No. 6243691 as applied above. Furthermore, Examiner takes official notice that it is old and well known in the art to use proxy bidding in an auction system. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate proxy bidding into the system in order to enable the system to bid on behalf of the bidder thus allowing the bidder to walk away from system and still have desired bids entered on his behalf.

***Conclusion***

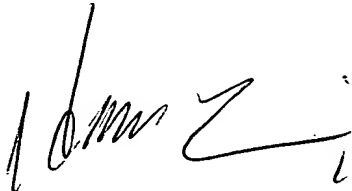
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



HANI M. KAZIMI  
PRIMARY EXAMINER